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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,673	02/10/2004	Doug Foster	DFI001	1135

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TOPE-MCKAY & ASSOCIATES
23852 PACIFIC COAST HIGHWAY #311
MALIBU, CA 90265

EXAMINER

MEISLIN, DEBRA S

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/775,673		FOSTER, DOUG	
	Examiner		Art Unit	
	Debra S Meislin		3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 7,11 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/10/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 17 and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Meador et al.

With respect to claim 17, Meador et al discloses a rod which is press fit with the proximal portion of the impact member.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond.

Meador et al discloses all of the claimed subject matter except for having a beveled head portion. Hallock discloses a beveled "19" head portion. Bond discloses a beveled "9" head portion. It would have been obvious to one having ordinary skill in the

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art to form the head portion of Meador et al as beveled to impact and countersink a workpiece as taught by Hallock or Bond.

5. Claims 3, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, as applied above, in further view of Borkowski.

Borkowski discloses a distal rubber surface engager. It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with a rubber surface engager to prevent marring of the workpiece as taught by Borkowski.

With respect to claim 9, Bond discloses a retractor "11". It would have been obvious to one having ordinary skill in the art to provide the device of Meador et al with a retractor to permit adjustments to be made as taught by Bond.

With respect to claim 12, Meador et al discloses a rod which is press fit with the proximal portion of the impact member.

6. Claims 4-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, and Borkowski, as applied above, in further view of Schutz.

Schutz discloses an extender "2" and a cock and release mechanism "8, 9". It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with an extender to force the impact member from the retracted to the extended position to impact a workpiece as taught by Schutz. It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with

cock and release mechanism to provide a faster insertion of the fastener as taught by Schutz.

With respect to claim 8, Meador et al discloses a rod which is press fit with the proximal portion of the impact member.

7. Claims 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, Borkowski, and Schutz as applied above, in further view of Eby.

Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool "136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. It would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, and Borkowski as applied above, in further view of Eby.

Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool "136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. It would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Borkowski.

Borkowski discloses a distal rubber surface engager. It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with a rubber surface engager to prevent marring of the workpiece as taught by Borkowski.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Bond.

Meador et al discloses all of the claimed subject matter except for having a retractor. Bond discloses a retractor "11". It would have been obvious to one having ordinary skill in the art to provide the device of Meador et al with a retractor to permit adjustments to be made as taught by Bond.

11. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Schutz.

Schutz discloses an extender "2" and a cock and release mechanism "8, 9". It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with an extender to force the impact member from the retracted to the extended position to impact a workpiece as taught by Schutz. It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with cock and release mechanism to provide a faster insertion of the fastener as taught by Schutz.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Eby.

Meador et al discloses all of the claimed subject matter except for having a handle pole with a sliding attachment. Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool "136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. It would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

13. Claims 7, 11 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Debra S Meislin', with a long horizontal flourish extending to the right.

Debra S Meislin
Primary Examiner
Art Unit 3723

May 17, 2005